



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/409,260	09/30/1999	JEFFREY D. SAFFER	01413.0010	5111

7590 12/14/2001

FINNEGAN HENDERSON FARABOW GARRETT  
& DUNNER L L P  
1300 I STREET N W  
WASHINGTON, DC 200053315

EXAMINER

MAHATAN, CHANNING

ART UNIT	PAPER NUMBER
----------	--------------

1631

DATE MAILED: 12/14/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/409,260

Applicant(s)

SAFFER ET AL.

Examiner

Channing S Mahatan

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-22 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 1631

## **DETAILED ACTION**

### *ART UNIT DESIGNATION*

The Group and/or Art Unit designated for this application has changed. Applicant(s) are hereby informed that future correspondence regarding this application should be directed to Group Art Unit 1631.

### *OBJECTION BY DRAFTSMAN*

Applicant(s) is (are) hereby notified that the required timing for correction of drawings has changed. See the last 6 lines on the sheet, which is attached, entitled "Attachment for PTO-948 (Rev. 03/01 or earlier)". Due to the above notification Applicant is required to submit drawing corrections with the time period set for responding to this Office action. Failure to respond to this requirement may result in abandonment of the instant application or a notice of a failure to fully respond to this Office action.

### *RENUMBERED CLAIMS*

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 11 (second occurrence) and 12-21 has been renumbered 12-22.

### *SEQUENCE COMPLIANCE*

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 C.F.R. § 1.821(a) (1) and (a) (2). This

Art Unit: 1631

application fails to comply with the requirements of 37 C.F.R. § 1.821 through 1.825 due to sequence as in the specification on page 3, lines 11, 14, 17, etc., and no submission of the following items. Therefore, applicant is required to submit the following:

1. As a separate part of the disclosure on paper copy, a "Sequence Listing" as 37 C.F.R. § 1.821(c).
2. A copy of the "Sequence Listing" in computer readable form as required by 37 C.F.R. § 1.821 (e).
3. A statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. § 1.821 (f) and 37 C.F.R. § 1.821 (g).

Applicants are given the same response time regarding this failure to comply as that set forth to respond to this office action. A complete response to this office action includes compliance with this sequence rule compliance requirement. Failure to comply may result in abandonment of this application.

#### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-10, drawn to a method for creating high-dimensional vectors by blocks or domains, classified in class 702, subclass 20. If this group is elected, then the below summarized specie election is also required.
- II. Claims 11-13, drawn to a method for creating high-dimensional vectors by surface characterization, classified in class 702, subclass 20. If this group is elected, then the below summarized specie election is also required.

Art Unit: 1631

III. Claims 14-22, drawn to a method for creating high-dimensional vectors by comparing biopolymer information, classified in class 702, subclass 20. If this group is elected, then the below summarized specie election is also required.

The inventions are distinct, each from the other because of the following reasons:

Invention I is comprised of a vocabulary of blocks or domains (1-dimensional) created with respective vector axis corresponding to blocks or domains defined and then determining string inclusion or not in each vector axis for high-dimensional vector determination (the domains in claim 7 are inclusive of sequence string blocks such as in claim 1). Invention II is comprised of defining biopolymers utilizing a surface (2-dimensional) of descriptors with corresponding vector axes and then determining descriptor inclusion or not in each vector axis for high-dimensional vector creation. Invention III is comprised of comparing biopolymer information to each biopolymer, arranging this into a square matrix followed by high-dimensional vector definition from said matrix followed by creating a distance matrix. The above methods for creating context vectors are classified within the same class and subclass, however such classification does not exclude such processes from restriction since it is shown that each invention contains divergent subject matter, and are distinctly different processes.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Art Unit: 1631

*SPECIES ELECTION REQUIREMENT APPLICABLE TO ALL GROUPS*

This application contains claims directed to the following patentably distinct species of the claimed invention:

- A. Biopolymer material is protein, claims 5, 9, 12, and 18
- B. Biopolymer material is nucleic acid, claims 6, 10, 13, and 19
- C. Other biopolymers described via motif domains, claim 8

A. The biopolymer material regarded as protein is composed of the (any of the 20 amino acids that have the basic formula  $\text{NH}_2\text{CHR}\text{COOH}$ ). B. The biopolymer material regarded as nucleic acid is composed of a number of nucleotides (adenine, cytosine, guanine, thymine, and uracil). C. Other biopolymers include motif domains, carbohydrate polymers, etc. The above biopolymer materials (protein, nucleic acid, and other) are of differing chemical types. Under these definitions the species are distinct, establishing a separate status in the art and a different field of search. Therefore, a species election is required.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, Claims 1-4, 7, 11, 14-17, and 20-22 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the

Art Unit: 1631

limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

*INVENTORSHIP AMENDMENT*

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

*EXAMINER INFORMATION*

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR 1.6(d)). The CM1 Fax Center number is either (703) 308-4242 or (703) 305-3014.

Art Unit: 1631

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Channing S. Mahatan whose telephone number is (703) 308-2380. The examiner can normally be reached on M-F (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Woodward, Ph.D., can be reached on (703) 308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Patent Analyst, Pauline Farrier, whose telephone number is (703) 305-3550 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

Date: *December 13, 2001*

Examiner Initials: *CSM*

*Ardin H. Marschel*  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER